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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,755	09/12/2003	Jeong J. Ma	MOT-CS22547RL	8148
35813	7590	08/09/2005	EXAMINER	
DESIGN IP-DEPT. MOT 5000 W. TILGHMAN STREET SUITE 153 ALLENTOWN, PA 18104			CHIANG, JACK	
			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,755

Applicant(s)

MA, JEONG J.

Examiner

Jack Chiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

CLAIMS

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-7, 10-16, 19, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodley et al. (US 2002/0021800).

Regarding claim 1, Bodley shows:

An ear mount (6);

A communication base unit (1-2);

A hinge unit (3-5, 23) that pivotally connects the communication base unit (1-2) to the ear mount (6) and allows the ear mount to be rotated between an open position (figs. 3, 7, 9) and a closed position (fig. 10);

A sensor (102) that activates the communication base unit when the ear mount is rotated into the open position (figs. 3, 7, 9) and deactivates the communication base unit when the ear mount is rotated into the closed position (fig. 10).

Regarding claim 11, Bodley shows:

An ear mount (6);

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A base housing (1-2);

A circuit carried on the housing (1-2) and including at least one of a transmitter and a receiver (19, behind 8);

A hinge unit (3-5, 23) that pivotally connects the communication base unit (1-2) to the ear mount (6) and allows the ear mount to be rotated between an open position (figs. 3, 7, 9) and a closed position (fig. 10);

A switch (102) carried in the base housing (1-2), the switch responsive to the open and closed positions (figs. 9-10) of the ear mount (6), the switch (102) automatically controlling the activation and deactivation of the circuit (i.e. 19), the circuit (i.e. 19) automatically responsive to the ear mount being in the open position (fig. 9) to power on the circuit and in the closed position (fig. 10) to at least temporarily power down the circuit.

Regarding claim 21, Bodley shows:

An ear mount (6);

A base (1-2) carrying a circuit (inside 1-2, i.e. 19) for short range communication with a device (cell phone);

A switch (102);

The steps of:

Turning the circuit off in response to the ear mount moving to a closed position (fig. 10);

Turning the circuit on when the ear mount moves to an open position with a portion of the ear mount spaced from the base (fig. 9).

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 3, 8-9, 17-18, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodley.

Regarding claim 20, 3, 8-9, 17-18, 22-23, Bodley shows:

An ear mount (6);

A communication base unit (1-2) having an earphone (behind 8) and a microphone (19);

A hinge unit (3-5, 23) that pivotally connects the communication base unit (1-2) to the ear mount (6) and allows the ear mount to be rotated between an open position (figs. 3, 7, 9) and a closed position (fig. 10), a hinge spring and a hinge spring socket (see spring and socket in fig. 21), and a plunger (i.e. 204);

A detent mechanism (see 144, 146, 148, 150) which holds the ear mount (6) between at least 20°-40° away from the base (1-2) (see fig. 7);

A detent mechanism (see 144, 146, 148, 150) comprising first and second plungers having complimentary v-shaped contours (see 144-146, 148-150);

A switch (102) that activates the communication base unit when the ear mount is rotated into the open position (figs. 3, 7, 9) and deactivates the communication base unit when the ear mount is rotated into the closed position (fig. 10), and a detect pin (see pin in 102).

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Bodley differs from the claimed invention in that the hinge spring and its socket are fixed in the base instead of the ear mount, therefore, the detect pin is not contacted the ear mount.

However, in Bodley, the ear mount (6) is rotatably (23, 3-5) mounted on the base unit (1-2). The majority parts of the hinge unit (i.e. 3-5) are housed in the base unit. In hinge design, it is common that the hinge parts can be shifted from one hinged part to another hinged part, and it would not affect the hinging operation because it is simply shifting the parts from one location to another.

Therefore, it would have been obvious for one of ordinary skill in the art to shift the hinge parts to the ear mount, in doing so, the ear mount would contact the detect pin because it is a part of the hinge. This variation can be considered as shifting location of parts and therefore would have been obvious for one of ordinary skill in the art, and in this case, it is shifting the hinge parts from the base unit to the ear mount, see *In re Japikse* 86, USPQ 70, CCPA 1950.

Regarding claims 2, 4-7, 9-10, 12-16, 18-19, Bodley shows:

The communication base unit (1-2) having an earphone (behind 8) and a microphone (19);

The sensor/switch and a detect pin (see area of 102 in fig. 26);

A detent mechanism (see 144, 146, 148, 150) which holds the ear mount (6) between at least 20°-40° away from the base (1-2) (see fig. 7);

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The detent mechanism (see 144, 146, 148, 150) comprising an elastomeric plunger located in a first bore having a female and male v-shaped contours (see 144-146, 148-150), and second plunger in a second bore (with 124 in fig. 13).

ARGUMENT

5. In response to the remarks (pages 1-3) filed on 5/27/05, in page 1, applicant mainly argues that Bodley activates the unit by rotating the boom, not the ear mount. The examiner will provide the following analysis for Bodley. First, there is a hinge (3-5) connecting three elements (housing 1, boom 2 and ear hook 6) together in Bodley, and anyone of these elements can be rotated with respect to each other.

For example:

operation 1: if the user holds the housing fixedly, the boom/ear hook can be rotated out;

operation 2: if the user holds the boom fixedly, the housing/ear hook can be rotated out;

operation 3: if the user holds both of the housing and ear hook fixedly, the boom can be rotated out;

operation 4: if the user holds both of the boom and ear hook fixedly, the housing can be rotated out etc.

In conclusion, at least operations 1-2 would meet the claimed limitations which is claiming activating the sensor when rotating the ear hook.

In page 1, applicant further argues that there is a switch 114 ... left ear and right ear position. Bodley teaches away ... because doing so would preclude the ability of Bodley ... to be configured for both right and left ear use. The examiner disagrees with

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applicant. Bodley's sensor 102 and switch 114 have separate designs and functions, Bodley is achieving the right and left ear mounting and the minimal operations as mentioned above. The examiner did not see any negative teaching from Bodley.

In page 2, about claim 20, applicant presents the same argument as in claim 1, see comments above.

In page 2, about claim 21, applicant first argues that "a circuit for short range communication...". The examiner likes to direct applicant to paragraph 0001 in Bodley, in which Bodley is using "Bluetooth". It is clearly that Bodley meets that claimed limitation.

Applicant further presents the same argument about the switching circuit, see comments in claim 1 above.

In pages 2-3, about claims 4, 13, 20, applicant argues about the detent mechanism. Applicant argues that Bodley teaches a mechanism that biases the ear hook 6 into a closed position ... does not hold the ear mount in an open position Applicant further cited fig. 7 and paragraph 0064..

The examiner disagrees. The Bodley's ear mount 6 can be held in the open position, see fig. 7, (note: check also the real product sold in the market). Further, Bodley's paragraph 0064 is describing how the hook 6 can be fixed when **not in use**. There is no contradiction in Bodley's description.

6. Applicant's arguments filed 5/27/05 have been fully considered but they are not persuasive. See comments above.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


Jack Chiang
Primary Examiner
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